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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/509,994
Filing Date: October 05, 2004
Appellant(s): CHENE ET AL.

Robert J. Patch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/03/2008 appealing from the Office action mailed 11/27/2007.

(1) Real Party in interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments

Amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of invention contained in the brief is substantially correct.

(6) Ground of Rejection to be Reviewed on Appeal

The appellants' statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Patent No. 1,674,983	Morton	06-1928
US Patent No. 4,492,488	Warshawsky.	01-1985

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, there is no antecedent basis for “said system”, lines 8-9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 1,674,983 Morton in view of US Patent No. 4,492,488 Warshawsky.

With respect to claims 16-19, Morton discloses a spectacle frame having a side-piece (2) and a spectacle face (3) interconnected by having at least one pivot point between one end of the side-piece and an end of the spectacle face (3), said ends having bearing faces fit for pairing up respectively one on top of the other, elastic means (14) for maintaining the bearing contact between said faces, wherein the frame further comprises two pivot parts (19, 24), each having a recessed zone (23, 25) limited by an at least partially curved surface, each of said pivot parts (19, 24) depending respectively on one of the side-piece (2) and spectacle face (3), said pivot parts being substantially orthogonal to each other and engaged one in the other through interlocking of their respective recessed zones so as to be able to pivot relative to each other, with the result that said system comprises two intangible pivot points within the limits permitted it by said recessed zones. The articulation system of Morton does not include a means allowing pivoting only in one or two predetermined planes. However, it is well-known in the art per se to limit the plane of pivoting whenever universality of pivoting is not desired. Warshawsky is evidence of this. Specifically, Warshawsky discloses an articulation system and teaches the inclusion of means to limit pivoting to a single predetermined plane. Accordingly, it would have been obvious to one of ordinary skill in the art to provide Morton with pivot restricting means as taught by Warshawsky so as to limit the pivoting action to a single predetermined plane as one of ordinary skill in the art would have found it desirable to limit the pivoting of Morton to a plane that is transverse to the plane of the head (i.e., the sweeping plane).

With respect to claim 20, the means for limiting the pivoting action can be seen in the figures of Warshawsky to be an axial notch.

(10) Response to Argument

Claim Rejections - 35 USC § 112

Appellants argue with respect to claim 16 that the failure to properly provide explicit antecedent basis for the recitation “said system” does not render the claim indefinite because it is evident that this recitation refers to the “spectacle frame” that the claim was amended to set forth in the response filed September 6, 2007. This has not been found to be persuasive.

In particular, it is a *non-sequitur* to recite “said system” without having first set forth “a system”. Claim 16 originally presented a “system” and this “system” was later changed to more specifically recite a “spectacle frame”. Accordingly, Appellants either failed to properly apply this change throughout the claim or else are making a broad reference to a no longer claimed “system”. In either instance, it would have been simple to correct, yet no correction was made.

Appellants appear to allege that “said system” is an inherent component of a spectacle frame. This clearly is not the case here. All spectacle frames do not inherently have a component commonly referred to as a "system". Appellants also appear to allege that one would understand that “said system” refers back to the spectacle frame given the file history. However, it is the claim in question that must be correct and definite, not the file history.

35 USC § 103 Rejection - Morton in view Warshawsky.

With respect to claim 16, Appellants argue that neither of Morton nor Warshawsky, nor the combination of them, would suggest to one ordinary skill in the spectacle art, any way to improve a spectacle frame having a side-piece and a spectacle face because Morton discloses a broom handle and Warshawsky discloses a spot swivel. This is not persuasive.

At the outset, it is well-settled that in a product claim it is the patentability of the product structure that is to be determined and not how such structure is intended to be used because claims to a product must be distinguished from the prior art in terms of structure, not function. See *Hewlett-Packard Co. v Bausch & Lomb Inc.*, 909 F.2d 1464, 15 USPQ2d 1525 (CAFC 1990). In other words, statements in a claim reciting the purpose or intended use of the claimed invention must be evaluated to determine whether such recited purpose or intended use results in a structural difference between the claimed invention and the prior art applied by the Examiner. See *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (CAFC 1997).

In the instant case, Appellants have chosen to name the intended field of use for the originally claimed articulation system. Claim 16 now purports to define a "spectacle frame" yet the only defined components of such "frame" are the components of the articulation system. Thus, Appellants have sought to distinguish the articulation system from the prior art by

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including where it is intended to be used. However, as previously noted above, no component of the spectacle frame additional to the articulation system has been recited. Thus, by definition as defined in the claim, the applied references define a "spectacle frame" in as much as they possess all of the structure that has been set forth to purportedly define a "spectacle frame". Appellants have failed to point out what specifically required "spectacle frame" components are not present nor do they provide any evidence of an art recognized specific meaning for "spectacle frame".

It is also interesting to note that the specification states that the invention is "a system of articulation" that is especially for equipment used "in robotics and for spectacle frames", see page 1, lines 3-5. The second paragraph of page 1 (lines 6-12) goes on to state that, "more precisely", the invention relates to a system of articulation between ends of first and second rigid elements. The paragraph bridging pages 2 and 3 states that the object of the instant invention is to provide an articulation capable of allowing rigid elements to occupy various relative angular positions. Nowhere in the specification is it disclosed that the invention is a spectacle frame or otherwise limited to a spectacle frame and the drawings do not illustrate a spectacle frame.

Accordingly, it appears that Appellants are seeking to rely on the intended field of use as the distinguishing feature of the articulation system to distinguish such from similar articulation systems of the applied prior art references.

Appellants argue on page 11 of the Brief that Morton is nonanalogous art because it is a broom handle and not a spectacle frame. However, Appellants have failed to identify what structure is recited and required by the naming of the frame as being a "spectacle" frame. Claim 16 has defined the "spectacle frame" as being comprised of a "side-piece" and a "spectacle face" that is interconnected by a pivot point. How is what is set forth by claim 16 structurally different from the side-piece, face and pivot point of Morton identified by the Examiner? The answer is that there is no structural difference. The inclusion of the term "spectacle" does not define any structurally distinguishing feature and is merely the naming of components to reflect an intended field of use.

Nevertheless, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, one is to decide if the reference is within the field of the inventor's endeavor. If it is not, one is to proceed to determine whether the reference is

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reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174. In this case, at the very least, Morton constitutes analogous art because it is reasonably pertinent to the problem being solved, i.e., the provision of articulation systems. Warshawsky also pertains to articulation systems and, more specifically, articulation systems limited in their direction of pivotal movement. Clearly, one seeking to enable articulated motion between two elements would turn to the articulated coupling art for a solution, especially when permitting articulated motion is exactly the purpose of an articulated coupling and this purpose does not change because of where one would like to use the coupling.

In response to Appellants' arguments, it should be noted that unobviousness cannot be established by attacking references individually when the rejection is based on a combination of references. Thus, the argument that the combination is improper because Warshawsky does not possess various of the claimed features when those features are present in the base reference, i.e., Morton, is not persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Patent Examiner

na

February 27, 2009

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